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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,261	09/10/1999	JOSEPH H. HENSHAW	PM-254839	2468

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WASHINGTON, DC 20004

EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 05/07/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/393,261

Applicant(s)

HENSHAW, JOSEPH H.

Examiner

Lauren Q Wells

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1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-16 and 18-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-16, 18-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 14-16 and 18-43 are pending. The Amendment received February 28, 2002, cancelled claim 17 and amended claims 15, 26, 30, 31, 33, and 39.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed February 28, 2002 (Paper No. 18) to the rejection of claims 14-43 made by the Examiner under 35 USC 102 and 103 have been fully considered and deemed not persuasive.

The Applicant's amendment filed February 28, 2002 is sufficient to overcome the rejection of claims 14-43 under 35 USC 112 second paragraph.

#### ***Priority***

The Examiner respectfully points out that Applicant has not met the requirements of 37CFR 1.78, wherein "If the application claims the benefit of an international application, the first sentence of the specification must include an indication of whether the international application was published under PCT Article 21(2) in English (regardless of whether benefit for such application is claimed in the application data sheet)".

#### ***102 Rejection Maintained***

The rejection of claims 14-16 and 18-43 under 35 U.S.C. 102(b) as being based upon a public use or sale of the invention is MAINTAINED for the reasons set forth in the Office Action mailed August 28, 2001, Paper No. 16, and those found below.

Applicant argues, "The applicant used Hudson to provide ground corn cob material so that the applicant could experiment with his invention or test it out. . . All that Hudson did was supply material to the applicant, at the applicant's request, for the applicant to test out his

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invention". This argument is not persuasive. The Examiner respectfully points out that showings of fact are much preferred to statements of opinion (In re Oelrich, 198 USPQ 210, 215 CCPA 1978), and that in the instant case, based on the preliminary injunction, it appears that Applicant's invention was in public use and/or sale more than one year prior to the date of Applicant's filing. Aside from producing the pellets in early 1993, it is respectfully pointed out that Applicant also obtained a certificate to do business under the name "Delmar Company" and named his product "Orbis Molasses Pellets" in April 1993. In summary, the preliminary injunction provides no evidence that the production of the pellet by Hudson Feed was done in confidence or that the product was not sold. Instead, the preliminary amendment gives the appearance that Applicant's invention was made of public use and sold.

***102 Rejection Maintained***

The rejection of claims 14-16 and 18-43 under 35 U.S.C. 102(c) as being abandoned by application is MAINTAINED for the reasons set forth in the Office Action mailed August 28, 2001, Paper No. 16, and those found below.

Applicant argues, "applicant did not delay patenting until he heard of Chuhran's filing for patent. The applicant filed his US application before he knew anything about Chuhran's filing. The Applicant did not become aware of Churhran's efforts to patent until Chuhran's U.S. patent issued". This argument is not persuasive. First, the Examiner respectfully points out that it is stated on pages 13-14 of the preliminary injunction, that in early 1996, Applicant became aware of Chuhran's filing. Second, the Examiner respectfully points out that while Applicant's petition to revive the international application was granted, without any apparent reason, two years

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lapsed between Applicant's personal and business troubles before an attempt was made to obtain a US patent. Thus, Applicant abandoned his invention.

***103 Rejection Maintained***

The rejection of claims 14-16 and 18-43 under 35 U.S.C. 103(a) as being unpatentable over Chuhran (6,136,340) is MAINTAINED for the reasons set forth in the Office Action mailed August 28, 2001, Paper No. 16, and those found below.

Applicant argues, "Chuhran appears to say nothing about using hybrid corn and he specifically removes the core material from his corn cobs and uses the resulting rings which remain for his purposes". This argument is not persuasive. Again, it would have been prima facie obvious to one having ordinary skill in the art at the time the invention was made to select any corn cob, including hybrids, since Chuhran discloses corn cob in general has the inherent rodenticidal property and since hybrid corn was known as a corn material as of the effective filing date, selection of this particular hybrid would have involved merely following the direction of Chuhran, absent a showing of unusual, surprising or unexpected results with specific corn hybrids.

Regarding the corn material, the Examiner respectfully points out that the instant invention is not directed toward a method of making the rodenticide. While Churhran relies on corn rings and the instant invention relies on corn cores, the final product, cellulose, is the same. The Examiner respectfully points out that a compound and its properties are inseparable. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Alpha cellulose was not disclosed in the original specification.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on T-F (6-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
May 1, 2002

RUSSELL TRAVERS  
PRIMARY EXAMINER  
GROUP 1200